

REMARKS/ARGUMENTS

Claims 1-28 are pending in this Application.

Claims 1, 13, and 23 are currently amended. Claims 1-28 remain pending in the Application after entry of this Amendment. No new matter has been entered.

In the Office Action, claims 1, 4-7, 10, 13, 16-19, 22-23 and 25-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2002/0135808 to Parry (hereinafter “Parry”), and in view of U.S. Patent Publication No. 2001/0005203 to Wiernik (hereinafter “Wiernik”).

Claims 11 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Parry, in view of Wiernik, and in further view of U.S. Patent No. 6,647,535 to Bozdagi (hereinafter “Bozdagi”).

Claims 2, 8, 14, 20, 24, and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Parry, in view of Wiernik, in further view of Bozdagi, and in further view of U.S. Patent No. 5,600,775 to King (hereinafter “King”).

Claims 3, 9, 15, and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Parry, in view of Wiernik, and in further view of King.

Claim Rejections Under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejections and request reconsideration and withdrawal of the rejections based on Parry, in view of Wiernik, in further view of Bozdagi, and in further view of King. The Office Action alleges that the combination of references teach or disclose all of the claimed limitations of the corresponding claims and that one having ordinary skill in that art at the time of the invention would have been motivated to incorporate the teachings of Parry and Wiernik with the teachings of Bozdagi and/or King.

Applicants respectfully submit that in the Office Action, a prima facie case of obviousness in the Office Action has not been established. In order to establish a prima facie showing of obviousness, three requirements must be satisfied: all limitations of a pending claim must be expressly or impliedly disclosed by prior art references; there must be a suggestion or

motivation in the art for the ordinarily skilled artisan to combine the limitations; and there must be a reasonable expectation of success in making such a combination. (M.P.E.P. § 2143).

Applicants submit that Parry, Wiernik, Bozdagi, and King, either individually or in combination, fail to teach or suggest at least one of the claimed limitations recited in each of the corresponding claims.

Claim 1

Claim 1 recites a computer-implemented method of generating a paper document based upon a plurality of multimedia documents storing multimedia information in electronic form. The method recited in claim 1 includes receiving input identifying a selection criterion. The method recited in claim 1 also includes analyzing the multimedia information stored by the plurality of multimedia documents to identify portions of multimedia information that satisfy the selection criterion. The identified portions of multimedia information recited in claim 1 include at least a first portion extracted from a first multimedia document from the plurality of multimedia documents and a second portion extracted from a second multimedia document from the plurality of multimedia documents. As recited in claim 1, the portions of the multimedia information that satisfy the selection criterion, including the extracted first portion and the extracted second portion, are printed on a paper medium to generate the paper document comprising a set of one or more printed pages.

The Office Action rejected claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Parry in view of Wiernik. Furthermore, the Office Action states that the Examiner does not see the inventive feature. The Office Action provides an example of a user going to multiple websites that contain a plurality of multimedia documents and then extracting certain portions (by highlighting or copy paste) which are then compared against some criteria and then pasted in any layout in a Word document. The Office Action then asks, “What is the difference?” The Office Action states that “this simple task” is accomplished by any word procesing document.

Applicants would like to point out to the Examiner that distilling an invention down to the “gist” or “thrust” of an invention (e.g., “this simple task”) disregards the requirement

of analyzing the subject matter “as a whole.” W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Applicants submit that the “simple task” referred to in the Office Action clearly disregards the subject matter as recited in claim 1 as a whole.

Furthermore, in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); Schenck v. Nortron Corp., 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). Applicants also respectfully disagree that “any word processing document” provides for the features as recited in claim 1. For example, nowhere has the Office Action identified where the word processing document, or the user creating the word processing document, performs “receiving input identifying a selection criterion” as required by claim 1. The Office Action merely alleges that certain extracted portions are then compared against “some criteria.” The Office Action also does not identify if certain portions of the multiple websites are extracted or if certain portions of the plurality of multimedia documents are extracted. Moreover, in the Office Action’s example, a reasonable interpretation of “some criteria” is a preference or desire that the user has for portions of the web sites. The preference or desire that the user already has for information is substantially different from receiving input identifying selection criteria as required by claim 1.

Therefore, Applicants submit that the example provided by the Examiner, even if the Examiner provide documentary evidence to the like, and “any word processing document” does not perform or disclose the recited features of claim 1 where multimedia information is analyzed to identify portions of multimedia information that satisfy received selection criteria, and where the extracted portions of the multimedia information that satisfies the selection criteria are printed on paper.

Further, Applicants respectfully submit that Parry and Wiernik, either individually or in combination, fail to teach or suggest the above-recited features of claim 1.

The Office Action relies on Parry to teach the feature of “printing the portions of the multimedia information that satisfy the selection criterion...” as recited in claim 1. However, Applicants respectfully disagree. The Office Action states that Parry does not teach “a selection criteria used to determine portions of multimedia information to print.” However, if Parry does not teach “a selection criteria used to determine portions of multimedia information to print,” as acknowledged in the Office Action, Parry cannot also teach the feature of “printing the portions of the multimedia information that satisfy the selection criterion ... on a paper medium to generate the paper document comprising a set of one or more printed pages” (emphasis added) as recited in claim 1 as Parry would then disclose printing information other than that which satisfies a selection criteria.

Further, Applicants submit that Parry does not teach or suggest the feature of “printing the portions of the multimedia information that satisfy the selection criterion, including the extracted first portion and the extracted second portion, on a paper medium to generate the paper document comprising a set of one or more printed pages” (emphasis added) as recited in claim 1. Instead, Parry describes a method and apparatus for printing digital video. (Parry: Paragraph 0007). The user may select to print certain frames, or a certain time frame in the digital video. For example, in Parry, the user may select every (x) number of video frames to print. (Parry: Paragraph 0026). Parry at most teaches printing “frames of a digital video.” However, the claim 1 requires printing on a paper medium a portion of multimedia information including at least a first portion extracted from a first multimedia document and a second portion extracted from a second multimedia document. Instead, Parry discloses the idea of printing frames of a digital video, i.e., a single multimedia document. Further, Parry does not teach that the general idea of printing frames of video requires printing frames from two different videos, as required in the pending claims. Thus, contrary to the assertion made in the Office action, Parry does not show the feature of printing multimedia information including at least a first portion extracted from a first multimedia document and a second portion extracted from a second multimedia document, as recited in the claim 1.

Moreover, Applicants submit that Wiernik fails to cure the deficiencies of Parry. While Wiernik discloses generating derived multimedia applications, Wiernik does not teach or suggest the feature of “printing the portions of the multimedia information that satisfy the selection criterion, including the extracted first portion and the extracted second portion, on a paper medium to generate the paper document comprising a set of one or more printed pages” as recited in claim 1. Nowhere does Wiernik disclose printing of a screen or information, or the extracting portions of information from a screen to teach or suggest the feature of printing multimedia information including at least a first portion extracted from a first multimedia document and a second portion extracted from a second multimedia document, as recited in the claim 1.

Based upon the above, Applicants submit that the even if Parry and Wiernick were combined as suggested in the Office Action (although there appears to be no motivation in the references for the combination), the resultant combination would not teach or suggest the features recited in claim 1, such as “printing the portions of the multimedia information that satisfy the selection criterion, including the extracted first portion and the extracted second portion, on a paper medium to generate the paper document comprising a set of one or more printed pages.”

Applicants also submit that Wiernik does not teach or suggest the features of “receiving input identifying a selection criterion” and “analyzing the multimedia information stored by the plurality of multimedia documents to identify portions of multimedia information that satisfy the selection criterion...” as recited in claim 1. The Office Action states that Wiernik discloses “selection criteria relating to multimedia applications.” Applicants, however, submit that the “selection criteria relating to multimedia applications” as disclosed by Wiernik is substantially different from the selection criteria as recited in claim 1 whereby multimedia information stored by the plurality of multimedia documents is analyzed to identify portions of multimedia information that satisfy the selection criterion and where the portions of multimedia information include at least a first portion extracted from a first multimedia document from the

plurality of multimedia documents and a second portion extracted from a second multimedia document from the plurality of multimedia documents.

In Wiernik, a selection criteria is a decision to link a sub-set of screens based on various pieces of data found in the screens to provide data-driven links. (Wiernik: Paragraph 0031). In Wiernik, a number of screens may be selected into a group also called a sub-set. (Wiernik: Paragraph 0034). According to Wiernik, the sub-set is also called a "selection." Applicants submit that the linking of screens of information into groups in Wiernik does not teach or suggest the features of "analyzing the multimedia information stored by the plurality of multimedia documents to identify portions of multimedia information that satisfy the selection criterion, the identified portions of multimedia information including at least a first portion extracted from a first multimedia document from the plurality of multimedia documents and a second portion extracted from a second multimedia document from the plurality of multimedia documents" as recited in claim 1. Firstly, Wiernik discloses that each screen is a record or entry in a database. A record or entry in a database does not necessarily teach or suggest that the screen actually "stores" multimedia information as required of the multimedia documents recited in claim 1. Second, nowhere does Wiernik disclose that identified portions of two multimedia documents are extracted and printed as recited in claim 1.

Finally, the Office Action also misquotes the Applicant argument that Wiernik does not teach or suggest the recited analyzing in claim 1 to identify portions of multimedia information that satisfy the selection criteria, where the portions of multimedia information include a first portion extracted from a first multimedia document and a second portion extracted from a second multimedia document. The Office Action states on page 18:

Applicant argues:

Wiernik does not show the recited analyzing to identify portions of multimedia information that satisfy the selection criterion, where the portions of multimedia information include a first portion extracted from a first multimedia document and a second portion extracted from a second multimedia document.

However the examiner respectfully disagrees. The applicant admits "By contrast, the recited selection criterion serves...to identify portions of multimedia information that satisfy the selection criterion" (pg 14/15), referring to the Wiernik selection criteria. The

The Office Action alleges that the Applicants were referring the Wiernik.

However, under a more careful reading, Applicants argued on page 14 of Applicants' response that:

The Wiernik selection criteria serve to determine which of the sub-set screens 4, 6, 8 (Fig. 1) are linked to a screen 2. By contrast, the recited selection criterion serves "to identify portions of multimedia information that satisfy the selection criterion." *Claim 1.* Wiernik does not perform an analysis of a screen for a portion of multimedia information, and so Wiernik does not teach a selection criterion that is used to select portions of multimedia information that satisfies the selection criterion..

Applicants clearly argued that the recited selection criteria of claim 1 serves "to identify portions of multimedia information." Applicants then argued that Wiernik does not perform such an analysis as recited in claim 1.

In response to misquoted argument, the Office Action further quotes Wiernik's recitation of using a template to "locate" various data on a screen as disclosing the recited analyzing in claim 1 to identify portions of multimedia information that satisfy the selection criteria, where the portions of multimedia information include a first portion extracted from a first multimedia document and a second portion extracted from a second multimedia document. Applicants submit that Wiernik does not teach or suggest the above feature as recited in claim 1. Instead, Wiernik discloses that the screen includes a template, which is used to locate various

data on the screen, and that these templates are referred to as a layout for placing data. (Wiernik: Paragraph 0009). Applicants submit that the template in Wiernik is not used to “locate” data in the screen, but to “locate,” layout or place data on the screen. The template in Wiernik has nothing to do with the recited analyzing in claim 1 to identify portions of multimedia information that satisfy the selection criteria, where the portions of multimedia information include a first portion extracted from a first multimedia document and a second portion extracted from a second multimedia document.

Claims 2-28

Applicants submit that independent claims 6, 11, 13, 18, 23, and 26 are allowable for at least a similar rationale as discussed above for the allowability of claim 1, and others. Applicants submit that dependent claims 2-5, 7-10, 12, 14-17, 19-22, 24-25, and 27-28 that depend directly and/or indirectly from the independent claims 1, 6, 11, 13, 18, 23, and 26 respectively, are also allowable for at least a similar rationale as discussed above for the allowability of the independent claims. Applicants further submit that the dependent claims recite additional features that make the dependent claims allowable for additional reasons.

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Examining Group 2178

PATENT

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,

/Sean F. Parmenter/

Sean F. Parmenter
Reg. No. 53,437

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 650-326-2400
Fax: 650-326-2422
SFP:am
60753772 v1